

REMARKS/ARGUMENTS

We thank the Examiner for the telephone discussions on April 1 and 6, 2010 where the Examiner confirmed that the rejection to claim 12 under 35 USC 102(e) was withdrawn and for the discussion regarding the enablement of claim 12.

Claim Amendments

By the present amendment, claims 12, 34, 35 and 37 have been amended as described below and claims 10 and 39 have been cancelled. In addition to the amendments described below, claim 38 has been amended to replace "levels" with "amount" to be consistent with claim 37 from which it depends. The amendments to the claims have been made without prejudice and without acquiescing to any of the Examiner's rejections. Applicant reserves the right to pursue any of the deleted subject matter in a further divisional, continuation or continuation-in-part application. No new matter has been entered by the present amendment and its entry is respectfully requested.

The office action dated January 21, 2010 has been carefully considered. It is believed that the amended claims and the following comments represent a complete response to the Examiner's rejections and place the present application in condition for allowance. Reconsideration is respectfully requested.

35 U.S.C. 102(e)

The Examiner rejected claims 10, 34-38 and 39 under 35 U.S.C. 102(e) as being anticipated by Xu et al. (US Patent No. 6,613,515, issued Sept. 2, 2003, filed Aug. 15, 2000). Claims 10 and 39 have been deleted and claims 34-38 thus no longer depend on claim 10, rendering the Examiner's rejection moot.

In view of the above, Applicant respectfully requests that the rejection to the claims under 35 U.S.C. 102(e) be withdrawn.

35 U.S.C. 112

The Examiner rejected claims 12 and 34-39 under 35 U.S.C. 112, first paragraph, alleging that the specification is non-enabling for these claims as it does not provide a nexus between metastasis and the expression levels of podocalyxin. Claim 39 has been deleted rendering the Examiner's rejection to this claim moot. In response, claim 12 (and thus dependent claims 34-38) have been amended to delete reference to metastatic cancer. Claim 12 thus is directed at whether a patient having cancer has a poor outcome. Applicant respectfully submits that the specification is enabling for determining whether a patient having cancer has a poor outcome based on the comparison of expression level of podocalyxin with other cancer associated markers as shown in Example I of the specification, and in particular, at page 43, lines 5-21 and

Tables 2 and 3. Applicant notes that the Examiner conceded on page 4 of the Office Action that the specification discloses that increased expression of podocalyxin is correlated with poor outcome and the Examiner points to page 42, Figure 2.

The Examiner further alleges that claims 12 and 35-39 encompass a method of determining whether or not any cancer is metastatic but alleges that the specification only discloses the expression of podocalyxin in invasive breast cancer tissues. Applicant has amended claim 12 to recite breast or ovarian cancer. Applicant respectfully submits that breast cancer and ovarian cancer are known to be correlated and thus, it would be expected that results from breast cancer would be predictive of ovarian cancer. Thus, the claims as amended are supported and enabled.

In view of the above, Applicant respectfully requests that the rejections under 35 U.S.C. 112, first paragraph, be withdrawn.

The Commissioner is hereby authorized to charge any fee (including any claim fee) which may be required to our Deposit Account No. 02-2095.

In view of the foregoing comments and amendments, we respectfully submit that the application is in order for allowance and early indication of that effect is respectfully requested. Should the Examiner deem it beneficial to discuss the application in greater detail, he is kindly requested to contact the undersigned by telephone at (416) 957-1678 at his convenience.

Respectfully submitted,

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